

REMARKS

Response to Determination Under 37 C.F.R. 1.121

On May 12, 2004 an Office Action was received to which the previous response to Office Action filed on February 19, 2004 was determined to be non-compliant. More specifically, the Examiner indicated that claim 46 recited the identifier "previously added" which is not one of the seven required status identifiers in accordance with 37 C.F.R. 1.111. Applicant kindly thanks the Examiner for giving the Applicant a one month time period to bring the claims into compliance. Applicant submits that the identifier for claim 46 has now been changed to recited "previously presented." Therefore, Applicants respectfully requests entry of the response to the Office Action that was mailed on November 19, 2003 as amended herein.

Status of the Claims

Claims 36-83 are pending in this application.

Claims 36-49, 52-57, 64 and 73-77 are rejected.

Claims 50, 51, 58-63 and 65-67 are objected to.

Claims 41, 58 and 65 have been amended. Support for these amendments can be found throughout the specification, claims, and drawings, as originally filed.

Claims 84 and 85 have been added. Support for these claims can be found throughout the specification, claims, and drawings, as originally filed.

Rejection of Claims 36-49, 52-57, 64 and 73-77 under 35 U.S.C. § 103

The Office Action rejected claims 36-45 under 35 U.S.C. § 103(a) as being unpatentable over Lang (U.S. Patent No. 6,390,634) in view of Herr (U.S. Patent No. 3,448,553). Applicant now respectfully traverses this rejection. The Office Action

indicated that Lang discloses all of the limitations of the claimed invention except for **the molded thin external plastic body shells**. The Office Action relied upon Herr to teach the deficiencies of Lang. More specifically, the Office Action stated “[i]t would have been obvious to one having ordinary skill in the art to have modified Lang to have made the mount and the head of a molded thin external plastic shell as taught by Herr **for the purpose of providing a more rigid and durable protective frame**.” Office Action p.3 [emphasis added]. Applicant wishes to point out that Herr fails in three ways. First, Herr does not teach a molded plastic shell as called for in claims 36 and 41 of the present application. Second, the Office Action improperly relied upon Herr for the purpose of “providing a more **rigid and durable protective frame**.” Lastly, one of ordinary skill in the art would not be motivated to combine Herr with Lang. Each of these three bases will now be addressed individually in detail.

The Office Action in pertinent part states that “Lang discloses all of the limitations of the claimed invention except for the **molded** frame external plastic body shells.” The Office Action went on to further state that it would have been obvious to modify Lang “...to have made the mount and the head of the molded thin external plastic shell as taught by Herr...” Applicant asserts that the Office Action improperly relied upon Herr which clearly does not teach or suggest a “molded” plastic shell. The Office Action pointed out that reference number 12 in Herr is the external plastic shell.

In pertinent part, the specification of Herr describes:

[a] covering of soft plastic material extends from the front portion of the resilient frame 10 to the area which surrounds the ball head 7 and its stem. This covering comprises a frame-shaped punched element 12 and a sheeting portion 14, which extends from said punched element 12 and on the rear of the mirror...[t]he covering is stretched around a cushioning pad, which consists of the foam slabs 19, 20 and 21 and which covers the rear side of the mounting frame 2 and resilient frame 10, which is snapped onto said mounting frame. Col. 4, lines 8-22.

The preceding passage from Herr suggests that the external plastic shell 12 is not molded, but rather is a flexible material made of soft plastic. It should be noted that the specification of Herr also describes heat sealing the plastic shell 12 to the edge 13, however, this does not in anyway describe actually molding plastic shell 12. See col. 4, lines 24-34. The specification of Herr suggests this reference cannot be relied upon to teach or suggest a molded plastic shell. Instead plastic shell 12, which is what the Office Action relied on to teach a molded plastic shell, is a flexible soft plastic material that is not molded. Since Herr fails to teach or suggest a molded plastic shell, it does not fill the gap left by Lang. Therefore, Applicant respectfully requests removal of the rejection of claims 36-45 and allowance thereof.

As pointed out above, the Office Action states that Herr was relied on "...for the purpose of providing a more rigid and durable protective frame." See Office Action, page 3, first paragraph. However, Applicant asserts that Herr does not teach or suggest providing a more rigid or durable protective frame. To the contrary, Herr states that "[i]t is an object of the invention to provide an internal rear view mirror which affords considerable protection from injury when the driver or a passenger is thrown against the mirror in case of an accident." Col. 1, lines 32-36. Additionally, the element 12 is a covering made of soft plastic material that stretches over and holds in place several foam layers 19, 20 and 21. See col. 4, lines 8-19. Applicant asserts that clearly Herr does not teach or suggest providing a more rigid and durable protective frame which is the Office Action's stated purpose for relying on this reference. Therefore, Applicant respectfully requests removal of the rejection of claim 36-45 since Herr clearly does not qualify for the purposes stated in the Office Action.

Additionally, Applicant asserts that the very nature of the Herr reference would not provide any suggestion to be combined with Lang. Herr provides no motivation to

be modified to have a molded shell or a rigid and durable frame. As discussed above, one of the objects of Herr is to protect the driver or passenger in a vehicle from being injured when they come in contact with an internal rear view mirror during an accident. The invention addresses the previous problem, wherein conventional mirrors had a hard (e.g., rigid) frame with sharp edges. Additionally, Herr is directed toward an improved internal rear view mirror as opposed to an external mirror. See col. 1, lines 23-40. Clearly, Herr teaches away from the Office Action's stated purpose of providing a more rigid and durable protective frame. There is no motivation to combine any of the teachings in Herr with Lang in order to render obvious claims 36-45 of the present application. Additionally, it would not be obvious to modify the external shell 12 in Herr to be molded and/or formed of rigid plastic since the objects of Herr teach away from this modification. Therefore, Applicant asserts that the Herr reference fails to qualify as a reference that would be combinable with Lang to arrive at the invention claimed in claim 36-45.

The rejection of claims 36-45 in the present application contain two independent claims (i.e., claims 36 and 41). All other claims (i.e., claims 37-40 and 42-45) are dependent upon each of the underlying base claims (i.e., claim 36 or claim 41). Claim 36 and amended claim 41 now both include the limitation of a plastic shell that is molded and are now allowable. The rejection of claims 37-40 and 42-45 should be removed since they depend from claims 36 or 41 which should be allowed in light of the statements above. Therefore, Applicant respectfully requests removal of the rejection of claims 37-40, 42-45 and allowance thereof.

Claims 46-49, 52-57, 64 and 73-77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang (U.S. Patent No. 6,390,634) in view of Herr (U.S. Patent

No. 3,448,553) in further view of Mittlehauser (DT 2740189). Applicant now respectfully traverses the rejection of claims 46-49, 52-57, 64 and 73-77.

With regard to Herr it appears that the basis for relying on this reference are the same basis relied upon in the rejection of claims 36-45 discussed above. Therefore, the rejection of claims 46-49, 52-57, 64 and 73-77 should be removed based on the arguments made above regarding the deficiencies of Herr.

Of the rejected claims, there are 4 independent claims (i.e., claims 46, 57, 64, 73) which all contain the term "molded" to describe the plastic shell components. As discussed above Herr fails to teach or suggest a molded plastic shell. Instead Herr teaches a flexible layer that is made of soft plastic. Col. 4, lines 18-19. Therefore, Applicant requests removal of the rejection of claims 47-49, 52-56 and 74-77 since Herr does not teach or suggest a molded plastic shell.

The previous argument concerning the Office Action's improper reliance on Herr also applies with respect to rejection of claims 46-49, 52-57, 64 and 73-77. As stated above the Office Action indicated that Herr was relied on "...for the purpose provided a more rigid and durable protective frame." See Office Action page 3, first paragraph. The specification of Herr clearly teaches away from this purpose. The specification of Herr states "[i]t is an object of invention to provide an internal rearview mirror which affords considerable protection from injury when the driver or passenger is thrown against the mirror in case of an accident." Col.1, lines 32-36. Additionally, the plastic shell 12 is a covering made of soft plastic material that stretches over and holds in place several foam layers 19, 20 and 21. See Col. 4, lines 8-19. Applicant asserts that it is clear that Herr does not teach or suggest providing a more rigid and durable protective frame as asserted in the Office Action. Therefore, Applicant respectfully request removal of the

rejection claims 46-49, 52-57, 64 and 73-77; since Herr clearly does not qualify for the purposes stated in the Office Action.

Lastly, the Applicant asserts that the very nature of the Herr reference will not provide any suggestion to be combined with Lang. As discussed above, one of the objects of Herr is to protect the driver or passenger in a vehicle from being injured with an internal rearview mirror during an accident. The invention addresses the previous problem, where in conventional mirrors had a hard (e.g., rigid) frame with sharp edges. Additionally, Herr is directed toward an improved internal rearview mirror as opposed to an external mirror. See Col. 1, lines 23-40. Clearly, Herr teaches away from the Office Action's stated purpose of providing a more rigid and durable protective frame. Therefore, Herr lacks any motivation to be combined with Lang. Additionally, it would not be obvious to modify the external shell in Herr to be molded since it is clear that the object of Herr teach away from this modification. That is, the object of Herr is to make the external shell soft and provide a cushion in the event of an accident. In light of Herr's shortcomings, Applicant asserts that independent claims 46, 57, 64 and 73 are not rendered obvious by Herr. Additionally, dependent claims 47-79, 52-56 and 74-77 which all depend from these independent claims will also fail to be rendered obvious by virtue of their dependency.

Claims 46-49, 53-57, 64 and 73-77 were further rejected in view of Mittlehauser (DT 2740189). The Office Action stated that:

Mittlehauser teaches that it is known to have a front and rear plastic shell having an overlapping butt joint (mirror 7, 8, 9, 12 and 21). It would have been obvious to one having ordinary skill in the art to have modified Lang in view of Herr to have included the front and rear plastic shells having the joint as taught by Mittlehauser for purposes of providing a better means of attachment for the front and rear shells.

With regard to the Mittlehauser, it should be noted that the reference is a disclosure that is “additive to” (the translation of the words “zusatz zu” on the front page of the application) the Mittlehauser published German patent application DE 2,732,489 (hereinafter referred to as the ‘489 reference). This means that the ‘489 reference should also be considered when assessing the teaching of Mittlehauser.

In pertinent part, claims 46, 57 and 73 of the present application claim a foam core that **anchors and supports** the shell (or shells, in the case of claims 46 and 73). Similarly, claim 64 describes a method where a void created by a first and second shell is filled with foam to form a rigid assembly bonded together by the foam. The specification addresses what is meant by “anchoring and supporting”. On page 6, paragraph 41, the last sentence states “[t]he foam 21 is injected into the external plastic shell halves 50 and 60 and, when shared, bonds to the internal surfaces of the shell halves 50 and 60 to secure and support them.” Further down on paragraph 44, it is stated “[t]he foam 18 and 25 used to fill the shells 17, 50 and 60 has adhesive properties which bond to the shells and thereby anchor them in position.” It is very clear that it is the foam that holds the front and rear shells together and not the joint by itself.

With respect to the ‘189 reference, it should be noted that Exhibit A of this response to Office Action contains the German language with the approximate English translation for each of the translations mentioned below. A translation of page 1, paragraph 1 in pertinent part reads “...thereby the base at its inside with projections/leads provides the edge part by bending ductile, which projections/leads of the base exhibits **behind-seizing hooks, against whose back the edge of the mirror body firmly rests...**” Further down on page 2 of the ‘189 reference the first full paragraph again states “...whereby the base at its inside provided with projections/leads and the edge part is equipped by bending the ductile projections/leads of the base

behind-seizing hook, against **whose back the edge of the mirror body rests firmly.**"

An examination of the figure of the '189 patent shows the edge part (5) wrapped around the edge of the base (3) with the mirror (6) abutting against and supporting the edge (5). This is more clearly shown in Figure 3 of the '489 reference. The patent teaches that the supporting edge is secured and anchored at the base by the mirror body firmly resting against it as opposed to foam.

Applicant points out that the butt joint in the '189 reference that is shown as encompassing portions of elements 5, 4 and 12 on the Figure does not indicate using foam for "anchoring and supporting" the front and rear shells as disclosed in claim 46 of the present application. It is maintained that neither the '189 reference nor the '489 reference teach or suggest using adhesive foam to bond the first and second pieces together. Applicant asserts that it is the mirror element (5) which anchors and supports the edge and base elements together and not the foam core as defined in claim 46 of the present application. This is clearly demonstrated by an examination of the '489 reference which in Figure 3 depicts the backing of the mirror (6) resting against hooks (12) which are pressed against the projections/leads (7) of the base (3) and are held in place by the back of the mirror (6) element. Additionally, none of the figures in the '189 or '489 references depict any type of foam material within the region of the butt joint.

In light of the arguments presented herein with regard to Herr and Mittlehauser, Applicant respectfully requests removal of the rejection to claims 46, 57, 64 and 73. Additionally, Applicant respectfully requests removal of the rejection with respect to claims 47-49, 52-56 and 74-77 since each of these claims are dependent claims that ultimately depend from the independent claims 46, 57, 64 and 73. Applicant now asserts that all rejections concerning the pending claims in the present application have been traversed. Therefore, this case can be allowed and moved forward to issue.

Allowable Matter

Applicant kindly thanks Examiner Wood for indicating that claims 50, 51, 58-63 and 65-67 were objected to but would allowable if rewritten in independent form. Applicant respectfully submits that claims 50 and 51 have been resubmitted as new claims 84 and 85 which include all of the subject matter in claims 50 and 51, plus the claims from which they depend. However, Applicant has elected at this time not to cancel claims 50 and 51 since the underlying base claims are presently being traversed by the Applicant. Additionally, the subject matter of claim 57 has been amended into claim 58, therefore claims 58-63 are now in allowable format. Additionally, the subject matter of claim 64 has been amended into claim 65, therefore, claims 65-67 are now in allowable form. Applicant also kindly thanks the Examiner for allowing claims 68-72 and 78-83.

CONCLUSION

It is respectfully submitted that in view of the above amendments and remarks the claims, as amended, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at
(248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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EXHIBIT A

The '189 Reference

Page 1, Paragraph 1:

German Language

Kraftfahrzeugrückblickspiegel mit einem schalen- oder trichterförmigen Gehäuse, in dessen Öffnung der Spiegelkörper angeordnet ist, wobei das Gehäuse einen die Öffnung umschliessenden Randteil aufweist, der für sich hergestellt und an dem übrigen Teile des Gehäuses (Grundkörper) befestigt ist, nach Patent ... (patentanmeldung P 27 32 489.6), wobei der Grundkörper an seiner Innenseite mit Vorsprüngen versehen und der Randteil durch Biegen verformbare, die Vorsprünge des Grundkörpers hinterfassende Haken aufweist, an deren Rückseite der Rand des Spiegelkörpers fest anliegt, dadurch gekennzeichnet, dass die freien Enden der Haken (12) mit ihrer Rückseite an einem Widerlager (20) anliegen, das mit dem Grundkörper (3) fest verbunden ist.

English Translation

Motor vehicle rearview mirror with flat or trichterfoermigen housings, in whose opening of the mirror bodies is arranged, whereby the housing exhibits the opening enclosing edge part, which is fastened for itself manufactured and to remaining parts of the housing (base), after patent... (patent application P 27 32 489,6), whereby the base at its inside with projections/leads provides and the edge part by bending ductile, which projections/leads of the base exhibits behind-seizing hooks, against whose back the edge of the mirror body firmly rests, in the fact characterized that the free ends of the hooks (12) with their back rest against a counter bearing (20), which is firmly connected with the base (3).

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German Language

Zusatz zu Patent (Patentanmeldung P 27 32 489.6)

Die Erfindung betrifft einen Kraftfahrzeugrückblickspiegel mit einem schalen- oder trichterförmigen Gehäuse, in dessen Öffnung der Spiegelkörper angeordnet ist, wobei das Gehäuse einen die Öffnung umschliessenden Randteil aufweist, der für sich hergestellt und an dem übrigen Teil des Gehäuses (Grundkörper) befestigt ist, nach Patent (Patentanmeldung P 27 32 489.6), wobei der Grundkörper an seiner Innenseite mit Vorsprüngen versehen und der Randteil durch Biegen verformbare die Vorsprünge des Grundkörpers hinterfassenden Haken ausgestattet ist, an deren Rückseite der Rand des Spiegelkörpers fest anliegt.

English Translation

Additive to patent..... (patent application P 27 32 489,6)

The invention concerns a motor vehicle rearview mirror with flat or trichterfoermigen housings, in whose opening of the mirror bodies is arranged, whereby the housing exhibits the opening enclosing edge part, which is fastened for itself manufactured and to the remaining part of the housing (base), after patent.... (patent application P 27 32 489,6), whereby the base at its inside provided with projections/leads and the edge part is equipped by bending the ductile projections/leads of the base behind-seizing hook, against whose back the edge of the mirror body rests firmly.